

REMARKS

Reconsideration of this application, as amended, is respectfully requested.

Initially, Applicants would like to thank the Examiner for indicating the allowability of claim 17 if rewritten in independent form to include all of the limitations of the base claim and any intervening claims.

In the Office Action, the Examiner rejects claims 1, 3, 5, 7, 9, 11, 13, 15, 22 and 24. Claims 1, 3, 5, 7, 9, 11, 13, and 15 are rejected under 35 U.S.C. §103(a) as being allegedly unpatentable over U.S. Patent No. 5,270,262 to Switky et al. (hereinafter "Switky") in view of U.S. Patent No. 5,266,739 to Yamauchi (hereinafter "Yamauchi"). Claim 22 is rejected under 35 U.S.C. §103(a) as being allegedly unpatentable over Switky in view of Yamauchi, and further in view of U.S. Patent No. 6,396,133 to James (hereinafter "James"). Claim 24 is rejected under 35 U.S.C. §103(a) as being allegedly unpatentable over Switky in view of Yamauchi, and further in view of U.S. Patent No. 5,739,582 to ElHatem et al. (hereinafter "ElHatem"). In response, independent claim 1 has been amended to clarify its distinguishing features.

Independent claim 1, as amended, recites a semiconductor device comprising a radiating plate, a semiconductor chip bonded onto the radiating plate, a rectangular-shaped resin wall, which retains the conductive member and surrounds the semiconductor chip, and a resin lid bonded to the upper end of the resin wall, where the semiconductor chip is sealed in a space enclosed by the resin wall, the radiating plate, and the resin lid.

Further, claim 1 recites a rectangular-shaped resin wall that has a first pair of opposing sides and a second pair of opposing sides. The conductive member extends through one of the first pair of opposing sides, while the radiating plate extends outward of the second pair of

opposing sides. The resin wall retains the conductive member extending through one of the first pair of opposing sides.

Support for the amendment can be found throughout the specification; specifically, on page 18, line 19 – page 19, line 15, and in Fig. 3. Therefore, Applicants respectfully submit that no new matter has been added by way of the amendment to claim 1.

The Examiner, in the present action, states that the cited references of Switky and Yamauchi disclose the above limitations. However, neither Switky nor Yamauchi disclose the elements as recited in independent claim 1. Specifically, neither reference provides for a rectangular shaped resin wall having a first and second pair of opposing sides, in which the resin wall holds a conductive member through one of the first pair of opposing sides, and where the radiating plate extends outward of the second pair of opposing sides.

Further, Yamauchi discloses, in Figs. 1-5, a resin housing 16 for surrounding a chip, with terminals 2 and 5. However, the terminals are connected to the resin wall such that the terminals are connected to a side face and an end face of the resin wall. The resin wall, however, is not connected to the radiating plate 1 in such a manner, as stated by the Examiner. Therefore, Yamauchi fails to disclose the limitations as recited in claim 1.

It has been held by the Courts that to establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). Accordingly, the 35 U.S.C. §103(a) rejection of independent claim 1 is improper as Switky or Yamauchi, individually or in combination, fail to disclose the limitations of independent claim 1.

Regarding claims 7 and 9, the Examiner states that Switky discloses first holes in the outside positions of the resin wall on the conductive member, and second holes in the region

extending through the resin wall of the conductive member, wherein the first holes overlap the space area between the second holes.

Switky, in Figs. 8-9, cited by the Examiner, does not show any first or second holes on the actual leads 13. The present invention clearly shows first holes 31 and second holes 32 located on the conductive member 30 in Fig. 3, which is not disclosed by Switky as alleged by the Examiner. An Examiner interview was conducted on this issue on February 2, 2004, and it was agreed upon that claims 7 and 9 would be amended to recite that the holes or first holes are provided in the conductive member and the holes or first holes are located in the outside positions of the resin wall on the conductive member, to clarify the language of the claim.

Support for the amendment is found throughout the specification; specifically, on page 20, line 24 – page 21, line 3, and in Figs. 3-5. Therefore, Applicants respectfully submit that no new matter has been added by way of the amendment to the claims. Switky, in Figs. 8-9, cited by the Examiner, does not show any holes on the actual leads 13. Accordingly, claims 7, 9 and 11 are distinguishable from the prior art.

Accordingly, Applicants respectfully submit that the references cited by the Examiner, individually or in combination, fail to render the present invention obvious. Therefore, Applicants respectfully request that the 35 U.S.C. §103(a) rejection of claims 1, 3, 5, 7, 9, 11, 13, and 15 under Switky in view of Yamauchi be withdrawn, the 35 U.S.C. §103(a) rejection of claim 22 under Switky in view of Yamauchi, and further in view of James be withdrawn, and the 35 U.S.C. §103(a) rejection of claim 24 under Switky in view of Yamauchi, and further in view of ElHatem be withdrawn. Accordingly, Applicants respectfully request allowance of claims 1, 3, 5, 7, 9, 11, 13, 15, 17, 22 and 24.

In view of the above, it is respectfully submitted that this application is in condition for allowance. Accordingly, it is respectfully requested that this application be allowed and a Notice of Allowance issued. If the Examiner believes that a telephone conference with Applicants' attorney would be advantageous to the disposition of this case, the Examiner is requested to telephone the undersigned.

Respectfully submitted,



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